



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Operations

Trademark Law Office 111

Trademark Attorney: Ingrid C. Eulin

Applicant : Itoya of America, Ltd.

Serial No. : 76/498,199

Filed : March 14, 2003

Mark : **XENON**

Attorney's Reference: 31730-187996

REQUEST FOR RECONSIDERATION

Honorable Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

In response to the Final Office Action, applicant again advises that the term XENON has no significance in the relevant trade. This information is contained in the first paragraph of the response filed December 9, 2003.

The Examining Attorney has issued a Final refusal of registration under Section 2(d) of the Trademark Act based upon Registration No. 2,340,074 issued April 11, 2000 for the mark XENON for "paper and cardboard."

Reconsideration and withdrawal of the refusal of registration based upon Registration No. 2,340,074 is requested for the following reasons.

Regardless of any similarities between the applicant's mark and the cited mark, the substantial differences between the respective products are such that confusion is clearly not likely.



08-04-2004

It is well-settled that likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and cited registration. See e.g., Paula Payne Products, Co. v. Johnson Publishing Co., 177 USPQ 76 (CCPA 1973); In re Chalet Chocolates, Inc., 212 USPQ 968 (TTAB 1982); Ferdinand Mulhens v. Sir Edward Ltd., 214 USPQ 298 (TTAB) 1981; Ziebart International Corp. v. Northern Instruments Corp., 212 USPQ 537 (TTAB 1981).

The Examining Attorney has indicated that

"[Applicant's] analysis is based upon a narrow reading of the registered goods. Here, the registration includes paper and cardboard. As the previously provided third-party registrations and the attached third-party registrations show, both pens and paper are produced and sold by the same source."

Applicant respectfully submits that a narrow reading of the registered goods is appropriate, and that the Examining Attorney has based her analysis upon too broad a reading of the registered goods.

Specifically, the cited registration covers "'paper and cardboard.'" It does **NOT** cover "paper" *per se*, it does **NOT** cover "cardboard" *per se*, it does **NOT** cover "goods made of paper," it does **NOT** cover "goods made of cardboard," it does **NOT** cover "paper or cardboard," it does **NOT** cover "goods made of paper and cardboard," and it does **NOT** cover "paper and cardboard products." It covers PAPER AND CARDBOARD as a single product.

A review of the Trademark Acceptable Identification of Goods and Services Manual (see attached Exhibit "B") confirms that "PAPER AND CARDBOARD" is listed as a *single* item. If "paper" and "cardboard" were to be covered as separate items, an appropriate identification would be "PAPER; CARDBOARD" both of which are listed in the Trademark Acceptable Identification of Goods and Services Manual as being acceptable as individual items (Exhibit "B").

Here, the registration does **NOT** cover the individual items "paper" and "cardboard." Rather, the registration covers the individual item "paper and cardboard."

The Examining Attorney has relied upon several third-party registrations which purport to cover both the applicant's goods and the registrant's goods.

A close review of those third-party registrations shows that they do not support the Examining Attorney's contentions.

While all of the noted third-party registrations cover goods of the type listed in this application (i.e., pens), they **DO NOT** cover goods of the type listed in the cited registration. The cited registration covers "paper and cardboard." Not one of the noted third-party registrations covers "paper and cardboard." They may cover items made of paper (e.g., writing paper, paper napkins, paper coasters, paper table cloths, paper mats), but they do not cover the individual item "paper and cardboard" which is the product covered in the cited registration.

The refusal of registration here is not premised upon any commercially reasonable evidence that there is a likelihood of confusion between the applicant's mark and product and the mark and product covered by the cited registration.

As noted above, the cited registration does **NOT** cover the item PAPER, and certainly does not cover "WRITING PAPER." It covers the single item PAPER AND CARDBOARD. There is absolutely no evidence that the product PAPER AND CARDBOARD is in any way related to applicant's WRITING PENS or that PAPER AND CARDBOARD moves in the same channels of trade as WRITING PENS or that PAPER AND CARDBOARD would be found in the same aisles in retail establishments as WRITING PENS.

In order to maintain a rejection under Section 2(d), it is not sufficient if confusion is merely "possible." A higher standard is required. Shatel Corp. v. Mao Ta Lumber & Yacht Corp., 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient.").

In the present case, it is submitted that not only is there no evidence that there would be a likelihood of confusion between applicant's "writing pens" and the registrant's "paper and cardboard," there is no evidence that such confusion would even be possible.

It is, therefore, requested that the Examining Attorney withdraw the refusal of registration and forward this mark for publication in the *Official Gazette*.

Respectfully submitted

August 4, 2004

By:



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Attorney for Applicant

EXHIBIT B

**Trademark Acceptable Identification
of Goods and Services Manual
Search Results**

The S field indicates the status of the record: A=added, M=modified, D=deleted. The TRI field indicates identifications that are acceptable in the USPTO, the JPO and OHIM (European Trademark Office). The Date field indicates the date of that status. Minor corrections to an entry, e.g., typos, are not considered changes in status.

TRIS TRI GOODS

Result of search for "paper":

N G 003 A 10/1/02 Abrasive paper

N G 003 A T 7/20/04 Abrasive paper [sandpaper]

N G 034 A T 7/20/04 Absorbent paper for tobacco pipes

N G 016 A T 7/20/04 Acid-resistant paper

N G 016 A 4/2/91 Adding machine paper

N G 016 A T 7/20/04 Adhesive note paper

N G 016 A T 7/20/04 Advertising signs of paper or cardboard

N G 016 A 10/1/01 Aluminum foil laminated paper for printing purposes

N G 006 A 4/2/91 Aluminum foil paper

N G 016 A 4/2/91 Art paper

N G 026 A T 7/20/04 Artificial flowers of paper

N G 017 A T 7/20/04 Asbestos paper

N G 019 A T 7/20/04 Asphalt roofing paper

N G 019 A 4/2/91 Asphalt roofing paper

N G 009 A 6/1/01 Automated paper money sorting machines

N G 016 A 8/1/04 Automatic paper clip dispensing machines for office or stationery use

N G 016 A T 7/20/04 Babies' diapers of paper

Y G 025 M 1/1/02 Baby bibs not of paper

N G 016 A T 7/20/04 Note paper

N G 016 A 10/1/94 Notebook paper

N G 016 A 4/2/91 Office paper drill machines

N G 016 A T 7/20/04 Office paper stationery

N G 016 A T 7/20/04 Offset paper

N G 016 A T 7/20/04 Offset printing paper for pamphlets

N G 016 A T 7/20/04 Oiled paper for paper umbrellas [kasa-gami]

N G 016 A T 7/20/04 Oilproof paper

N G 016 A 4/2/91 Onion skin paper

N G 016 A 4/2/91 Opaque paper

N G 016 A 4/2/91 Packing paper

N G 016 A T 7/20/04 Paper

N G 028 A 4/2/91 Paper airplanes

N G 016 A T 7/20/04 Paper and cardboard

Y G 016 A 4/2/91 Paper baby bibs

N G 016 A 10/1/94 Paper badges

N G 007 A T 7/20/04 Paper bag making machines

N G 016 A 4/2/91 Paper bags

N G 010 A 4/2/91 Paper bags and envelopes for sterilizing medical instruments

N G 016 A T 7/20/04 Paper bags and sacks

N G 016 A 4/2/91 Paper bags for packaging

N G 016 A 6/1/01 Paper baking cups

N G 016 A 4/2/91 Paper banners

Y G 027 M 5/1/02 Paper bath mats

N G 016 A T 7/20/04 Paper board

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IC TRI GOODS

Result of search for "cardboard":

- N G 016 A T 7/20/04 Advertising signs of paper or cardboard
- N G 016 A T 7/20/04 Boxes of paper or cardboard
- N G 016 A 4/2/91 Cardboard
- N G 016 A 6/1/01 Cardboard backing for binding books
- N G 016 A 4/2/91 Cardboard boxes
- N G 016 A 9/4/01 Cardboard carriers for food and beverages
- N G 016 A 4/2/91 Cardboard cartons
- N G 016 A 4/2/91 Cardboard containers
- N G 021 A T 7/20/04 Cardboard cups
- N G 016 A 4/2/91 Cardboard floor display units for merchandising products
- N G 016 A T 7/20/04 Cardboard made from paper mulberry [senkasi]
- N G 016 A 4/2/91 Cardboard mailing tubes
- N G 016 A T 7/20/04 Cardboard packaging
- N G 016 A T 7/20/04 Collapsible cardboard boxes
- N G 016 A T 7/20/04 Containers for ice made of paper or cardboard
- N G 016 A T 7/20/04 Corrugated cardboard
- N G 016 A T 7/20/04 Corrugated cardboard boxes
- N G 017 A 8/1/04 High-density polyethylene film with adhesive back to be used in cardboard and corrugated